

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAMIL VALARIK

Appeal No. 1999-2727
Application No. 08/809,315

HEARD: JULY 10, 2001

Before CALVERT, FRANKFORT, and BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 3-5, which are all of the claims pending in this application.

BACKGROUND

The appellant's invention relates to a hockey stick blade having an adhesive layer on at least one side thereof, the adhesive layer comprising grains of corundum, ceramics,

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limestone, glass, rubber, textiles and plastics (claim 1) and methods of applying the adhesive layer of claim 1 to a hockey stick blade (claims 3-5). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are the following Canadian patents:

Saytar	909814	Sep. 12, 1972
Spratt	984420	Feb. 24, 1976

Claims 1, 3 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Spratt.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Spratt in view of Saytar.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 14) and two prior Office actions (Paper Nos. 7 and 12)¹ for the examiner's complete reasoning in support of the

¹ We remind the examiner that the Manual of Patent Examining Procedure (MPEP) § 1208 expressly provides that incorporation by reference in an answer may be made only to a **single** other action.

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rejections, and to the appellant's brief (Paper No. 13) and reply brief (Paper No. 15) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied Spratt and Saytar references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

There does not appear to be any dispute that each of the claims before us on appeal requires that the adhesive layer comprise grains of each of the seven materials (corundum, ceramics, limestone, glass, rubber, textiles and plastics) recited in the claims.² In other words, an adhesive layer

² While appellant's original claims provide written descriptive support for the adhesive layer comprising all seven of the recited grains, the remainder of appellant's specification does not appear to provide clear support or antecedent basis for the combination of all of the recited
(continued...)

comprising grains of some, but not all, of the seven recited materials would not meet the limitations of the claims on appeal.

Spratt discloses a hockey stick blade having an abrasive material bonded or secured to the blade by an appropriate adhesive and a method of applying the abrasive material and adhesive to the blade. The method includes the steps of applying a quick-drying thermosetting non-absorbent adhesive to a wooden hockey stick blade and spraying a moisture-absorbing abrasive grit on the adhesive. Spratt teaches that "the abrasive grit may be carborundum, sand, aluminum oxide (alumina [also known as corundum]), silicon carborundum or even a glass grit" (page 3). For quick repairs during a hockey game, Spratt prefers a grit which absorbs moisture from the adhesive, particularly an alumina grit such as Alundum oxide, because the alumina grit absorbs the moisture in the epoxy, thus providing a quick-drying technique (page 3). On page 4, Spratt teaches that, if the abrasive grit is to be

²(...continued)
materials in the adhesive layer as required by 37 CFR § 1.75(d)(1). We leave this issue to be addressed by the primary examiner in the event of further prosecution.

applied to the blade during the original manufacture of the stick, the blade is typically dipped into an epoxy, coated with fiberglass, and again dipped into an epoxy. After the second dipping in the epoxy adhesive resin, "the grit may be applied to the blade ... by dipping, sprinkling, spraying or the like."

The examiner recognizes that Spratt discusses only two (corundum and glass) of the seven grain materials recited in the claims and, further, appears to teach use of these materials in the alternative, rather than in combination. However, the examiner asserts that "[a]ll of the materials [recited in the claims] are commonly known, and to the ordinarily skilled artisan any or all of them would have been suitable for use as the grit material for Spratt's coating" (Paper No. 7, page 2). The examiner adds, on pages 3-4 of the answer, that

[t]he ordinarily skilled artisan considering Spratt would have obviously recognized that all manner of grain materials would have been suitable for Spratt's grit. The fact that Spratt only denotes several, when literally thousands would suggest themselves, does not indicate that appellant's particular grit would have been unobvious. The choice of a known material suitable

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for the disclosed purpose is not unobvious. *In re Leshin* 125 USPQ 416.

While appellant does not dispute that the materials recited in the claims were all known materials at the time of appellant's invention, appellant points out that Spratt does not teach or suggest that all of these materials are suitable for use as grit in the abrasive coating (brief, page 9). Appellant further contends, especially with respect to rubber and textiles, that the examiner has made no showing that the claimed grains are abrasive (reply brief, page 3).

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

In this case, the examiner has not provided any evidence that one skilled in the art at the time of appellant's invention would have recognized all of the materials, in

particular rubber and textiles, recited in appellant's claims as abrasive and suitable for use in an adhesive grit layer with adhesive as taught by Spratt. Thus, it is not apparent to us why one of ordinary skill in the art would have been motivated, in the absence of appellant's disclosure, to provide grains of all seven materials recited in appellant's claims in combination in the abrasive grit layer of Spratt.

The examiner (answer, page 4) has also asserted that appellant has not demonstrated that the particular combination of materials recited by appellant yields unexpected results. While this is true, we also observe that the test of obviousness is not whether appellant's invention yields unexpected results. Rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Indeed, a prima facie case of obviousness is established where the reference teachings would appear to be sufficient for one of ordinary skill in the art having those teachings before him to make the proposed combination or modification. See In re

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Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

As the evidence adduced by the examiner is insufficient to have suggested to one of ordinary skill in the art appellant's claimed invention so as to establish a prima facie case of obviousness of the subject matter of the claims on appeal, the burden has not shifted to appellant to present evidence of unobviousness, such as unexpected results.

Accordingly, we shall not sustain the examiner's rejection of claims 1, 3 and 4 as being unpatentable over Spratt.

We have reviewed the additional teachings of Saytar but find nothing therein which cures the above-noted deficiency of Spratt. Accordingly, we shall also not sustain the examiner's rejection of claim 5 as being unpatentable over Spratt in view of Saytar.

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CONCLUSION

To summarize, the decision of the examiner to reject
claims 1 and 3-5 under 35 U.S.C. § 103(a) is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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JENNIFER D. BAHR)	
Administrative Patent Judge)	

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